

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-11, 16-26 and 46-58 are pending in the application, with 1, 16, 46, and 53 being the independent claims. Claims 1, 4, 16, 46, and 53 are sought to be amended. Claims 12-15 and 27-45 were canceled in a previous amendment. New claims 57 and 58 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Priority

The Examiner has noted that the present application 09/864,293 is a Continuation-In-Part (CIP) of Applications 09/559,964 and 09/393,390. The Examiner has alleged that this Application, 09/864,293, does not benefit from an earlier filing date due to inadequate support. (See Office Action, page 2). Applicants elect not to substantively respond to the Examiner's contentions at this time, but reserve the right to do so in the future.

Rejections under 35 U.S.C. § 103

In paragraphs 5, 6 and 7 of the Office Action, claims 1, 2, 4, 6, 7, 9-11, 16, 17, 21, 22, and 24-26 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent 6,516,341 to Shaw et al. ("Shaw") in view of U.S. Patent

5,848,396 to Gerace ("Gerace") in further view of U.S. Patent 5,933,811 to Angles *et al.* ("Angles"). Furthermore, claims 3, 5, 18, and 20 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Shaw in view of Gerace and Angles as applied above, in further view of U.S. Patent 5,794,210 to Goldhaber *et al.* ("Goldhaber"). Claims 8, 23, and 46-56 have also been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Shaw in view of Gerace and Angles as applied above, in further view of U.S. Patent 6,332,127 to Bandera *et al.* ("Bandera"). Applicants respectfully traverse the rejections.

The combination of references does not teach or suggest all the features of claim

1. For example, claim 1 recites the following:

pre-populating at least one field of the advertisement with
address location information relating to the user of the
hand-held device.

The Examiner appears to rely on Shaw to teach this element of claim 1. Shaw appears to describe a system in which advertisements are integrated into an e-mail system. In particular, as the user is reading or creating an e-mail message, the system displays a banner advertisement. In some cases, the banner advertisement may be interactive. By clicking on a banner advertisement, the user can find out more information about the subject matter of the banner advertisement. By clicking on the banner advertisement, the user may also be provided with an e-mail message template with the advertiser's e-mail address filled in the addressee section. The e-mail message that is brought up is in accordance with FIG. 12 of Shaw. As shown in FIG. 12 of Shaw, such an e-mail would be from the user to the advertiser. The e-mail may be used to

indicate interest and may include pre-filled text to that effect. See Shaw, col. 13, line 14 - col. 14, line 5.

Further with Shaw, in setting up a new account with the server, the user provides identification information such as a telephone number and fills out a representative survey that charts the user's interest in a variety of activities. This information is stored at the server and at the device the user is using. See Shaw col. 11, line 48 - col. 12, line 67.

On page 4 of the Office Action, the Examiner states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to that user address information can be sent along with the pre-filled email. One would have been motivated to do this in order to provide relevant user information for better profiling and tracking of the user."

Applicants respectfully disagree. At most, Shaw describes automatically generating an e-mail including the advertiser's e-mail address and providing a message in the text area indicating interest in a subject matter of the banner advertisement. Applicants point out that Shaw only describes pre-filling an e-mail sent to the advertiser with content, i.e., pre-filling an email with the advertiser's e-mail address as the addressee and a textual message indicating interest. The information pre-filled in the e-mail is the same for every user that clicks on a particular banner advertisement.

This is in contrast to the claimed invention. In the claimed invention, the field of the advertisement is pre-filled with "address location information relating to the user of the hand-held device" (see claim 1). Thus, in contrast to Shaw, the information pre-filled by the claimed invention differs from user to user.

Applicants assert that user-specific pre-filling represents an added layer of functionality and complexity that would not have been obvious at the time of the invention in view of the cited references. In particular, Shaw does not teach or suggest a way of extracting data from storage 206 or at server 104, where user identification information is stored, and inserting such information in an e-mail to the advertiser. In fact, such information is only described in Shaw as it pertains to setting up a new account for the user at the server. Shaw never teaches or suggests allowing that identification data to be used for any other purpose.

There are other differences between claim 1 and Shaw. For example, claim 1 recites pre-filling an advertisement with user address location information. Shaw does not teach or suggest pre-filling a field in an advertisement. Instead, Shaw teaches pre-filling an e-mail.

Therefore, Applicants assert that claim 1 is patentable over Shaw. Gerace, Angles, Goldhaber, and Bandera do not solve the deficiencies of Shaw, so claim 1 is also patentable over these references.

Accordingly, Applicants assert that claim 1 and its dependent claims are patentable over the cited references, considered alone or in combination. Moreover, independent claims 16, 46, and 53 and their respective dependent claims are also patentable over the cited references for reasons similar to those described above with respect to claim 1. Thus, Applicants request that the rejection of claims 1-11, 16-26, and 46-56 be reconsidered and withdrawn.

Reply to Office Action of October 19, 2006

AUFRICHT *et al.*
Appl. No. 09/864,293

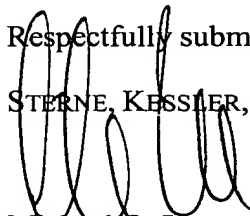
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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